

## REMARKS/ARGUMENTS

### Status of Claims

Claims 1-39 are pending in this application, and claims 9-12 and 22-36 have been withdrawn from consideration. (As further explained below, claim 14 has been canceled). Prior claim rejections under Section 112 of the Patent Statute have been removed. Claims 1-8, 13, 15-21, and 37-38 are still rejected under Section 102, and/or under obviousness-type double patenting. Claims 14 and 39 have been objected to, but have also been designated as potentially allowable.

### Rejections Under 35 U.S.C. 102

All of the rejections for anticipation remain as in the prior Office Action. Thus, claims 1-5, 15-17, and 19-21 are rejected under 35 U.S.C. 102(b), as being anticipated by Sugimoto et al, U.S. Patent 5,322,864 ("Sugimoto"). Claims 1-7, 16-17, 19-21 and 37-38 stand rejected under 35 U.S.C. 102(b), as being anticipated by Geeck, U.S. Patent 4,748,194. Claims 1-2, 4-8, and 16-20 continue to be rejected under 35 U.S.C. 102(b), as being anticipated by Lutz et al, U.S. Patent 5,011,627 ("Lutz").

Applicant continues to maintain that the pending claims are not anticipated by any of the references. While other distinctions were noted in the Response of October 21, 2005, the presence of the limiting term "aluminizing composition" is clearly a primary distinguishing feature. The Examiner maintains that "...a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art". (Page 3 of present Office Action). Applicant emphasizes that the limiting term here is more than just an "intended use".

The Examiner again cited sections of MPEP 2111.02, regarding the significance of limitations in the preamble of a claim. Applicant has made note of that section, and understands the Examiner's conclusion that preamble language

may not always limit claim scope. However, Applicant also notes that other cases noted in that same section of the MPEP support the proposition that preamble limitations can serve to distinguish over the prior art. As an example, *Bell Communications* states that “[A] claim preamble has the import that the claim as a whole suggests for it”. (55 F.3d 615, 620; Fed. Cir. 1995). In the present instance, the claim “as a whole” clearly suggests an organic-based aluminizing composition. None of the references specifically suggests such a limitation. Moreover, there is no clear evidence that any of the compositions described in the references would effectively accomplish the objectives of this invention.

As the MPEP explains (again, section 2111.02), other cases also emphasize the importance of preamble limitations for various types of claims. Sections of the *Pitney Bowes, Inc.* case (which cites other cases) are illustrative: “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” (182 F.3d 1298, 1305, Fed. Cir. 1999). In the present case, the preamble cites key limitations, which were discussed at length in the earlier Response. The preamble also clearly gives “meaning” to the claim – a meaning never suggested in Sugimoto, Geeck, or Lutz.

Applicant thus maintains that the originally-presented claims are not anticipated by the applied references. However, there is at this time a desire to reduce the issues present in this Application. Thus, changes have been made to the pending claims, in accordance with the substance of claims deemed potentially allowable by the Examiner. Despite these changes, the scope of the originally-presented claims is not being surrendered, and Applicant reserves the right to prosecute those claims in one or more subsequent patent applications related to the present case.

Claim 1 has been amended to include the limitation that the powder for the aluminizing composition comprises an alloy of aluminum and silicon. This language is taken from claim 14, which the Examiner indicated contained allowable subject matter. Thus, claim 1 should now be deemed patentable. Those

claims which depend from claim 1 are also patentable. In view of these changes, claim 14 is now superfluous, and has been cancelled.

Two other independent claims, 20 and 37, have been amended in similar fashion, to recite the alloy composition. Claim 20 is directed to subject matter like that of claim 1, but in a bit more of a specific context. Claim 37 is directed to an article (e.g., the turbine component of claim 39) which is at least partially covered by the aluminizing composition. In view of the Examiner's indication of patentable subject matter, these claims (and those dependent from them) should also be allowed.

The undersigned had a brief, but helpful, conversation with the Examiner regarding this case, during the week of January 9, 2006. Several of the issues described herein were discussed in that conversation. Moreover, the idea of adding the term "substantially" to claim 37 was brought up during that talk. The Examiner seemed to think there would be no issue with the inclusion of that term. It should be noted that "substantially free of hexavalent chromium" had also been recited in original claim 16, and set forth in paragraph 14 of the specification.

Lastly, Applicant makes note of the submission of new claim 40. The claim is, in substance, a re-writing of claim 39. Claim 39 incorporated the subject matter of original claim 37. The new claim is consistent with the Examiner's indication of allowable subject matter, and does not raise any new issues. Some of the claims which were withdrawn, claims 33-36, have been cancelled (without prejudice), for administrative purposes

#### Double Patenting Rejection

Claims 1, 2, 6-8, 13-19, 31 and 37 remain provisionally rejected under the judicially-created doctrine of obviousness-type double patenting, in view of co-pending Application No. 10/836,001 (Lawrence Kool). (Applicant assumes that claim 31 is not part of this rejection, since the claim had been withdrawn). The issues here appear to be identical to those in the first Action, i.e., whether the pending claims are not identical to, but not distinct from, the claims of No.

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Appl. No. 10/633,887

Reply to Office Action of December 23, 2005

10/836,001.

In brief, Applicant concedes that both claimed inventions happen to describe "aluminizing compositions". However, there are significant differences between the respective claims as well. Some of those differences were set forth in the Previous Response.

Despite Applicant's belief that the invention of 10/836,001 is distinct from the present case, there is a desire to advance prosecution at this time. Thus, an appropriate Terminal Disclaimer is filed herewith. The Disclaimer would effectively equalize the term of a patent issuing from this prosecution with a patent issuing from the reference-application.

#### Conclusion

Applicant submits that all of the pending claims, as well as new claim 40, are in allowable condition. If additional matters require discussion, Applicant suggests that a telephone call may be very useful.

Respectfully submitted,



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